REMARKS

In the Office Action dated January 2, 2003, claims 1, 3-9, and 11-38 were rejected as being unpatentable under 35 U.S.C. 103(a) in view of the combination of U.S. Patent No. 6,270,011 to Gottfried (hereinafter, "Gottfried") and U.S. Patent No. 6,247,129 to Keathley et al. (hereinafter, "Keathley"). However, the combination of Gottfried and Keathley does not teach one skilled in the art all of the features of the claims, at least, for the following reasons.

In the systems and methods defined by the claims, an authorization number or a PIN is recited as part of the claim features for authorizing a purchase over a computer network, such as the Internet. Claim 33 is provided below to illustrate the features of one of the defined methods that recite a PIN.

> 33. (Amended) A method of making purchases over the Internet comprising the steps:
>
> transmitting an ATM card number which will be used to pay a purchase price over the Internet from a web browser on a consumer's computer to an on-line merchant's web site;
>
> forwarding said first number over the Internet from said on-line merchant's web site to a verification computer;
>
> transmitting over the Internet from said verification computer to said web browser on said consumer's computer a request for a PIN associated with said ATM card number;
>
> inputting said PIN into said web browser on said consumer's computer and transmitting said PIN over the Internet from said consumer's computer to said verification computer;
>
> determining using said verification computer whether said ATM card number and said PIN are valid; and

transmitting a message over the Internet from said verification computer to said on-line merchant's web site indicating whether said ATM card number and PIN are valid.

The Office action states that "Gottfried teaches the authorization data is the fingerprint, instead of a number, Keathley teaches the authorization data is a number." The Office Action further states that "it would have been obvious to one with ordinary skill in the art at the time invention was made to modify Gottfried's [system] in view of Keathley's [authorization data] for the purpose of cost saving." Gottfried, however, explicitly teaches one skilled in the art not to modify Gottfried in the way proposed by the Office Action.

The Manual of Patent Examining Procedures ("M.P.E.P.") states that "[i]t is improper to combine references where the references teach away from their combination." M.P.E.P. Section 2145. Gottfried teaches away from the combination proposed by the Office Action when it states the following:

> "In existing credit card security systems, heavy reliance is placed on the possession of the card itself and identification numbers that the user must protect and remember. These identification techniques lead to problems if the card is stolen and the identification number is copied or forgotten. Those numbers are sent through the communication media with limited security or certainty that the purchase is being made by the right person, who legally possesses the card and is authorized to use it." Gottfried, Column 1, lines 30-39.

Thus, Gottfried teaches away from using identification numbers because it states that such techniques lead to problems, and moreover, as a solution to these problems, Gottfried explicitly teaches the use of fingerprints for authorization. Accordingly, the proposed modification of Gottfried with Keathley is improper

because the proposed modification would be in conflict with Gottfried's explicit teachings

Thus, to be explicit, Gottfried does not show:

- "transmitting a query for said authorization number" (claim 1 and 17, see also claims 9, 22, 37, and 38),
- "transmitting said authorization number over said network from said consumer location (claim 1, see also claims 9, 17, 22, 37, and 38),
- "after said account number and said authorization number are received . . ., verifying the validity of . . . said account number" (claim 1 and 17, see also claims 9, 22, 37, and 38),
- "transmitting . . . a request for a PIN associated with said ATM card number" (claim 33, see also claim 34),
- "inputting said PIN into said web browser . . . and transmitting said PIN over the Internet" (claim 33, see also claim 34),
- "determining whether said ATM card number and said PIN are valid" (claim 33, see also claim 34),
- "transmitting a message over the Internet . . . indicating whether said ATM card number and PIN are valid" (claim 33, see also claim 34),
- "transmitting over the Internet a query for a PIN" (claim 35, see also claim 36),
- "receiving at said verification computer said PIN" (claim 35, see also claim 36), and
- "transmitting a message over the Internet . . . indicating whether said ATM card number and PIN are valid" (claim 35, see also claim 36).

None of these claimed features are carried out or implemented by the techniques and systems of Gottfried. Such features are also not shown by Keathley.

Keathley does mention the use of a PIN (Keathley at column 6, lines 47-60). However, this discussion in Keathley explicitly shows the local offline use of a PIN for verification purposes and not the use of a PIN over a computer network. Specifically, Keathley shows that a computer access device (e.g., a user's PC) can support the entry of PIN which is used for comparison with a reference PIN in the user's integrated circuit card, which is comparable to a user's credit card. Thus, Keathley also teaches away from the use of PIN or authorization number over a computer network such as the Internet by explicitly teaching a local offline verification technique.

Neither Keathley nor Gottfried show the use of an authorization number or PIN for the completing online transactions. This is because Gottfried and Keathley are in line with the state of the art that is discussed in the background section of the present application. The background section states that "[w]hen making purchases over the Internet using an ATM card, however, security considerations take on an added importance because, unlike with transactions at ATM machines, PINs are presently not used in ATM transactions on the Internet." The lack of such a feature in Keathley and Gottfried supports the non-obviousness of the subject claims.

Moreover, the systems and methods defined in the present application are advantageous over Gottfried and Keathley in that they provide security measures that are typically consistent with point of sale purchase techniques that use an authorization number and these systems and methods are relatively easily implemented within conventional transaction systems and networks without the added complexity and cost of adding a finger print database (Gottfried), an authorization adapter that is locally connected to a consumer's PC (Gottfried), encryption of finger print data (Gottfried), integrated circuit in a card for verification (Keathley). Thus, for example, by using techniques such as by bypassing an online merchant during part of the online transaction, sufficient security from theft of information is provided while still providing the convenience of the use of existing cards with associated authorization numbers for such transactions.

Reconsideration and withdrawal of the obviousness rejection of independent claims 1, 9, 17, 22, 33, 34, 35, 36, 37, and 38 are respectfully requested based on the above.

It also requested that dependent claims 3-8, 11-16, 18-21, 23-32 be allowed, at least, because the independent claims from which they depend are allowable.

In the Office Action, claims 22-26, 32 and 36 were rejected under 35 U.S.C. 112, first paragraph, because the claims are effectively single "means" claims. The Office Action relies on Fiers v. Revel, 25 USPQ2d 1601, 1606 (Fed cir. 1993) for this rejection. The Office Action states that in Fiers, the U.S. Court of Appeals for the Federal Circuit affirmed a rejection under 35 U.S.C. 112 of a claim reciting a single element that did not literally use "means-plus-function" language.

In Fiers, the court, in relevant part, affirmed a determination that a patent application did not comply with the written description clause of 35 U.S.C. 112, first paragraph. In contrast, rejections that are issued for "single means claims" are issued for lack of compliance with the enablement clause of 35 U.S.C. 112, first paragraph, not the written description clause of that section. In Fiers, the court simply stated that the issue that they were addressing was analogous to that which arises for "single means claims." Therefore, Fiers cannot be presented for the position that a "single means claim" rejection for lack of enablement claim is applicable to a claim does not literally use "means-plus-function."

Moreover, even if the rejection is for lack of enablement, the Office Action does not establish a prima facie case because the Office Action does not present facts or analysis why the claims are not supported by the specification with respect to enablement. Accordingly, withdrawal of the rejection is requested.

Applicant requests reconsideration of the rejections and the issuance of a notice of allowability.

In addition, consideration and allowance of the following new claims are also requested:

39. The method of claim 33 wherein the forwarding comprises forwarding to the verification computer a session identifier that includes an electronic address for the consumer's computer, which is forwarded with the ATM card number.

40. The system of claim 34 wherein the on-line merchant's web site is configured to generate a session identifier that includes an electronic address for the consumer's computer and configured to forward the ATM account number with the session identifier to the verification computer.

Gottfried and Keathly, neither individually nor in combination, show or suggest such techniques.

The present Office Action issued over a year after the last response that the Applicant filed. Applicant understands that the U.S. Patent and Trademark Office has been faced with a high volume of new patent applications. However, since this patent application has been pending for over three and a half years and has received substantive examination which based at least on the above indicates that it is allowable for patentability, prompt attention to the patent application with respect to issuance of a notice of allowability is respectfully requested.

Respectfully submitted,

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